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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/751,630

12/29/2000

Joanne S. Walter

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26884 7590 08/20/2007  
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EXAMINER

LIVERSEGE, JENNIFER L

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

08/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/751,630

Applicant(s)

WALTER, JOANNE S.

Examiner

Jennifer Liversedge

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/751,630 filed on June 20, 2007.

The amendment contains original claims: 3, 8, 10, 12, 16 and 18-20.

The amendment contains amended claims: 1, 9 and 17.

The amendment contains previously presented claims: 2, 4-7, 11 and 13-15.

The amendment contains new claims: 21-26.

### ***Claim Objections***

Claims 23-25 are objected to because of the following informalities: two (2) claims are cited as claim 23. For purposes of examination, claims have been renumbered. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6, 8-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub No. US 2002/0091562 A1 to Siegel et al. (further referred to as Siegel), and further in view of "Protecting E-Privacy: Washington Must Step In" by Marcia Stepanek (further referred to as Stepanek).

Regarding claims 1 and 21-22, Siegel discloses a method for prescribing personal data

preferences (page 1, paragraph 7) comprising the steps of:

a) coupling an electronic consumer device to a computer of a business (page 2, paragraphs 13 and 22-23);

b) accessing a personal data preferences program executed by the computer through use of the electronic consumer device that enables a consumer to create a personal privacy profile choosing, selecting, and then assigning opt in or opt out privacy options to one or more specific, distinct, and different types of personal data collected and maintained by the business for the purpose of identifying and limiting the discrete

types of data the business is authorized, by the customer's choice of opt in, to collect, use, and disseminate in accordance with the personal privacy profile data type options selected as opt in by the customer (page 1, paragraph 7; page 2, paragraphs 13 and 23);

c) recording consumer selection of the privacy options via the consumer device by the computer (page 2, paragraphs 13 and 22-23);

d) coding selected privacy options by the computer (page 2, paragraph 24; page 3, paragraph 35);

e) downloading coded privacy options to the consumer device by the computer (page 2, paragraph 24; page 3, paragraphs 33-34; page 4, paragraphs 41-42; page 5, paragraph 44);

f) transferring the coded privacy options to a consumer storage medium separate from the consumer device by the computer (page 2, paragraphs 23-24; page 3, paragraphs 33-34; page 4, paragraphs 41-42; page 5, paragraph 44);

g) reading the coded privacy options from the consumer storage medium by a transaction computer during a transaction between the consumer and the business (page 2, paragraphs 13 and 23-24); and

h) limiting the collection, use, and dissemination of the personal data by the transaction computer in accordance with the coded privacy options (page 1, paragraphs 7 and 12; page 4, paragraph 39; page 5, paragraph 44).

Siegel discloses where the information gathered includes but is not limited to the data types of history of purchases from the business by the consumer, demographic

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data, amount purchased, frequency of purchase, coupon used, payment method used, time of day, week, and year purchased (page 1, paragraph 12; page 2, paragraphs 14 and 23-24; page 3, paragraph 35; page 4, paragraphs 39-43; page 5, paragraph 44).

Siegel does not disclose where consumers may opt out of having this information collected. However, Stepanek discloses where consumers may opt out of having this information collected (pages 1-2). It would be obvious to one of ordinary skill in the art to modify the privacy options for data collection with opt out feature for collection of personal data as disclosed by Siegel to adapt the use of opting out of purchase data collection as disclosed by Stepanek. The motivation would be that purchase information is another form of personal data (as it indicates interests and shopping patterns, etc.) and users may not want this information collected and stored by a merchant, such as is stated by Stepanek.

Siegel does not disclose where the electronic consumer device is coupled to a computer of a business selling goods or services, where the business selling goods or services provides a personal data preferences program on the coupled computer. However, Stepanek discloses where the consumer is connected to a business offering the personal preferences program (pages 1-2). It would be obvious to one of ordinary skill in the art to adapt the use of maintaining the personal preference program at any phase in the consumer transaction process. Whether the limitation on information gathering is directed to an online advertising business or a business offering products for sale, the limitation on information gathering is stipulated. The motivation of adhering to a customer's wish for limiting data gathering at any point during the transaction by

any interested parties would be that the personal preference programming offers the business a way to build customer trust and loyalty and therefore consumers would be more likely to return to this trusted source for future purchasing needs knowing their personal preferences regarding data collection would be honored and respected.

Regarding claim 9, Siegel discloses a method of encoding personal data preferences of a consumer for use during a purchase transaction (page 1, paragraph 7) comprising the steps of:

- a) coupling an electronic consumer device to a computer of a business (page 2, paragraphs 13 and 22-23);

- b) accessing a personal data preferences program executed by the computer through use of the electronic consumer device that enables a consumer to create a personal privacy profile choosing, selecting, and then assigning opt in or opt out privacy options to one or more specific, distinct, and different types of personal data collected and maintained by the for the purpose of identifying and limiting the discrete types of data the business is authorized, by the customer's choice of opt in, to collect, use, and disseminate in accordance with the personal privacy profile data type options selected as opt in by the customer (page 1 , paragraph 7; page 2, paragraphs 13 and 23);

- c) permitting the consumer to select of the privacy options via the consumer device by the computer (page 2, paragraphs 13 and 22-23);

- d) encoding selected privacy options by the computer (page 2, paragraph 24; page 3, paragraph 35); and

e) downloading coded privacy options to the consumer device by the computer for later downloading to a consumer storage medium separate from the consumer device (page 2, paragraph 24; page 3, paragraphs 33-34; page 4, paragraphs 41-42; page 5, paragraph 44);

f) reading the coded privacy options from the consumer storage medium by a transaction computer during the purchase transaction (page 2, paragraph 24; page 3, paragraphs 33-34; page 4, paragraphs 41- 42; page 5, paragraph 44) to limit the collection, use, and dissemination of the personal data by the transaction computer in accordance with the encoded selected privacy options (page 1, paragraphs 7 and 12; page 4, paragraph 39; page 5, paragraph 44).

Siegel discloses where the information gathered includes but is not limited to the data types of history of purchases from the business by the consumer, demographic data, amount purchased, frequency of purchase, coupon used, payment method used, time of day, week, and year purchased (page 1, paragraph 12; page 2, paragraphs 14 and 23-24; page 3, paragraph 35; page 4, paragraphs 39-43; page 5, paragraph 44).

Siegel does not disclose where consumers may opt out of having this information collected. However, Stepanek discloses where consumers may opt out of having this information collected (pages 1-2). It would be obvious to one of ordinary skill in the art to modify the privacy options for data collection with opt out feature for collection of personal data as disclosed by Siegel to adapt the use of opting out of purchase data collection as disclosed by Stepanek. The motivation would be that purchase information is another form of personal data (as it indicates interests and shopping



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patterns, etc.) and users may not want this information collected and stored by a merchant, such as is stated by Stepanek.

Siegel does not disclose where the electronic consumer device is coupled to a computer of a business selling goods or services, where the business selling goods or services provides a personal data preferences program on the coupled computer. However, Stepanek discloses where the consumer is connected to a business offering the personal preferences program (pages 1-2). It would be obvious to one of ordinary skill in the art to adapt the use of maintaining the personal preference program at any phase in the consumer transaction process. Whether the limitation on information gathering is directed to an online advertising business or a business offering products for sale, the limitation on information gathering is stipulated. The motivation of adhering to a customer's wish for limiting data gathering at any point during the transaction by any interested parties would be that the personal preference programming offers the business a way to build customer trust and loyalty and therefore consumers would be more likely to return to this trusted source for future purchasing needs knowing their personal preferences regarding data collection would be honored and respected.

Regarding claim 17, Siegel discloses a system for prescribing personal data preferences (page 1, paragraph 7) comprising:

A processing unit (page 3, paragraph 26);

A network interface in communication with the processing unit and operable to be

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coupled to a computer of a business via an electronic network (page 2, paragraphs 13 and 22-23; page 3, paragraphs 26-27); and

Memory in communication with said processing unit and containing a plurality of instructions which, when executed by the processing unit (page 3, paragraph 26), enable

a) an electronic consumer device to connect to the computer to access a personal data preferences program of the computer via the electronic network (page 2, paragraphs 13 and 22-23), the personal data preferences program being operable to enable a consumer to create a personal privacy profile by choosing, selecting, and then assigning opt in or opt out privacy options to one or more distinct, and different types of personal data collected and maintained by a business for the purpose of identifying and limiting the discrete types of data the business is authorized, by the customer's choice of opt in, to collect, use, and disseminate in accordance with the personal privacy profile data type options selected as opt in by the customer (page 1, paragraph 7; page 2, paragraphs 13 and 23);

b) allowing a consumer via the consumer device to select the privacy options (page 2, paragraphs 13 and 22-23);

c) convert selected privacy options into a personal data model (page 2, paragraph 24; page 3, paragraph 35);

d) code the personal data model in a format readable by a retail terminal of the business during a purchase transaction to limit the collection, use, and dissemination of

the personal data by the retail terminal (page 1 , paragraphs 7 and 12; page 2, paragraphs 13 and 23-24; page 4, paragraph 39; page 5, paragraph 44);

e) transmit a coded personal data model to the consumer device, wherein the consumer device is operable to transfer a received coded personal data model onto a personal data preferences storage medium of the consumer which is separate from the consumer device and which is read by the retail terminal during the purchase transaction (page 2, paragraph 24; page 3, paragraphs 33-34; page 4, paragraphs 41-42; page 5, paragraph 44).

Siegel discloses where the information gathered includes but is not limited to the data types of history of purchases from the business by the consumer, demographic data, amount purchased, frequency of purchase, coupon used, payment method used, time of day, week, and year purchased (page 1, paragraph 12; page 2, paragraphs 14 and 23-24; page 3, paragraph 35; page 4, paragraphs 39-43; page 5, paragraph 44). Siegel does not disclose where consumers may opt out of having this information collected. However, Stepanek discloses where consumers may opt out of having this information collected (pages 1-2). It would be obvious to one of ordinary skill in the art to modify the privacy options for data collection with opt out feature for collection of personal data as disclosed by Siegel to adapt the use of opting out of purchase data collection as disclosed by Stepanek. The motivation would be that purchase information is another form of personal data (as it indicates interests and shopping patterns, etc.) and users may not want this information collected and stored by a merchant, such as is stated by Stepanek.

Siegel does not disclose where the electronic consumer device is coupled to a computer of a business selling goods or services, where the business selling goods or services provides a personal data preferences program on the coupled computer. However, Stepanek discloses where the consumer is connected to a business offering the personal preferences program (pages 1-2). It would be obvious to one of ordinary skill in the art to adapt the use of maintaining the personal preference program at any phase in the consumer transaction process. Whether the limitation on information gathering is directed to an online advertising business or a business offering products for sale, the limitation on information gathering is stipulated. The motivation of adhering to a customer's wish for limiting data gathering at any point during the transaction by any interested parties would be that the personal preference programming offers the business a way to build customer trust and loyalty and therefore consumers would be more likely to return to this trusted source for future purchasing needs knowing their personal preferences regarding data collection would be honored and respected.

Regarding claims 2-3 and 15-16, Siegel discloses the method wherein step a) includes coupling the consumer device to the computer via an electronic network and where the electronic network is the Internet (page 2, paragraphs 13 and 22-23).

Regarding claims 4-6, 13-14 and 19-20, Siegel discloses the method coding the selected privacy options into a barcode, a magnetic strip readable format and a magnetic strip on a card (page 2, paragraph 24; page 3, paragraphs 33-34).

Regarding claims 8, 10, 18 and 23-25, Siegel discloses the method wherein the consumer device is one of a personal computer or a personal digital assistance (page 2, paragraphs 13 and 22-24; page 3, paragraph 34).

Regarding claim 11, Siegel discloses the method further comprising the steps of:

f) transferring downloaded encoded selected privacy options onto a code storage device, the code storage device being readable by the transaction computer during a purchase transaction (page 2, paragraphs 13 and 23-24; page 3, paragraphs 33-34; page 4, paragraphs 41-42; page 5, paragraph 44);

g) reading the downloaded encoded privacy options from the consumer storage medium by the transaction computer during the purchase transaction (page 2, paragraphs 13 and 23-24; page 3, paragraph 33; page 4, paragraphs 40 and 42).

Regarding claim 12, Siegel discloses the method wherein the code storage device comprises one of an access card and a barcode (page 2, paragraph 24; page 3, paragraphs 33-34).

Regarding claim 26, Siegel does not disclose recording privacy preferences of a customer via a self-service terminal of the seller (page 4, paragraph 40).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siegel and Stepanek as applied to claim 1 above, and further in view of "Love Bug Virus Raises New Concerns About Password Security" by PR Newswire in May 2000 (further referred to as PR Newswire).

Regarding claim 7, neither Siegel nor Stepanek disclose the method of transferring the coded privacy options to a key flock. However, PR Newswire discloses the method of transferring the coded privacy options to a key flock (page 2, lines 29-32). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of personal customer storage devices for storing personal data as disclosed by Siegel in combination with Stepanek to adapt the storing of personal information in a key fob as disclosed by PR Newswire. The motivation would be that a key fob is one of many forms of personal storage devices and users find the use of key fobs convenient as they can be stored on a user's key chain for safe keeping.

### ***Response to Arguments***

Applicant's arguments filed 6/20/2007 have been fully considered but they are not persuasive.

Applicant argues that Siegel and Stepanek are not properly combinable. Examiner respectfully disagrees as both relate to the exchange of customer personal data during transactions. Siegel discloses that customers prefer to exercise control on the use of identifying information, limiting private information available to third parties

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linking his identify to his purchases (page 1, paragraph 7). Siegel discloses where the consumer gains the convenience of electronic communication of selected information while maintaining control over personal information (page 5, paragraph 44). While Siegel does not disclose the ability to opt-out of data collection, as discussed in the rejected claims above, Stepanek discloses where a business offers an opt-out policy for customers, recognizing that some customers do not want personal information collected and that the goodwill gained from honoring this wish results in customer loyalty. It would be obvious to adapt the use of maintaining the personal preference program at any phase in the consumer transaction process. Whether the limitation on information gathering is directed to an online advertising business or a business offering products for sale, the limitation on information gathering is stipulated. The motivation of adhering to a customer's wish for limiting data gathering at any point during the transaction by any interested parties would be that the personal preference programming offers the business a way to build customer trust and loyalty and therefore consumers would be more likely to return to this trusted source for future purchasing needs knowing their personal preferences regarding data collection would be honored and respected.

The Love Bug Virus reference simply discloses storing personal information on a key fob as recited in claim 7, the combination of Siegel and Stepanak disclose the opt in opt out privacy options.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.




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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KAMBIZ ABDI  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Kambiz Abdi', written over the printed name and title.

Jennifer Liversedge

Examiner

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